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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: George V. Guyan et al.

Appln. No.: 09/305,146

Filed: May 4, 1999

For: COMPONENT BASED INFORMATION LINKING DURING CLAIM PROCESSING

Attorney Docket No: 10022/252-1

Examiner: Rimell, S.

Art Unit: 2175

Conf. No.: 1663

Mail Stop Appeal Briefs
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

☒ Reply Brief (original and 1 copy).

☒ Return Receipt Postcard.

Fee calculation:

☒ No additional fee is required.

☐ Small Entity.

☐ An extension fee in an amount of $_____ for a _____-month extension of time under 37 C.F.R. § 1.136(a).

☐ A petition or processing fee in an amount of $_____ under 37 C.F.R. § 1.17(_____).

☐ An additional filing fee has been calculated as shown below:

	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra		Small Entity		or	Not a Small Entity	
						Rate	Add'l Fee		Rate	Add'l Fee
Total		Minus				x $25=			x $50=	
Indep.		Minus				X100=			x $200=	
First Presentation of Multiple Dep. Claim						+$180=			+ $360=	
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Fee payment:

☐ A check in the amount of $_____ is enclosed.

☐ Please charge Deposit Account No. 23-1925 in the amount of $_____. A copy of this Transmittal is enclosed for this purpose.

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☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925. A copy of this Transmittal is enclosed for this purpose.

Respectfully submitted,

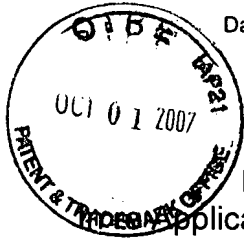October 1, 2007
Date

John C. Freeman, Esq. (Reg. No. 34,483)

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PATENT
CASE NO. 10022/252-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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<tr><td>INFORMATION LINKING</td><td>)</td></tr>
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REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is in response to the Examiner's Answer mailed July 30, 2007.

REPLY

A.   Status of Claims

At pages 2 and 3 of the Examiner's Answer, the Examiner indicated that the

rejection of claim 66 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No.

5,950,169 to Borghesi et al. was being vacated and that claim 66 was being allowed.

Accordingly, please amend the "Status of Claims" section at pages 2 and 3 of

Appellants' Amended Appeal Brief filed on November 13, 2006[1] (hereinafter

"Appellants' Amended Appeal Brief") to read as follows:

Claims 1-21 and 23-40 are canceled.

Claims 22 and 41-65 are finally rejected under 35 U.S.C. § 112, first paragraph,

for failing the written description requirement.

Claim 67 is finally rejected under 35 U.S.C. § 102(e) as being anticipated by U.S.

Patent No. 5,950,169 to Borghesi et al.

Claim 66 is allowed.

The previously mentioned rejections of claims 22, 41-65 and 67 are the subject

of this Appeal.

B. Grounds of Rejection to be Reviewed on Appeal

As mentioned above in Section A, the Examiner has indicated in the Examiner's

Answer that the rejection of claim 66 under 35 U.S.C. § 102(e) as being anticipated by

Borghesi et al. was being vacated and that claim 66 was being allowed. Accordingly,

please amend the "Grounds of Rejection to be Reviewed on Appeal" section at page 14

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[1] Appellants have filed an Appeal Brief on July 24, 2006, an Amended Appeal Brief on November 13, 2006 and a revised Summary of Claimed Subject Matter section on March 28, 2007. The undersigned left a phonemail message with Examiner Rimell in late September of 2007 offering to file a consolidated Appeal Brief that would take into account the three filings mentioned above and the withdrawal of the rejection of claim 66 in the Examiner's Answer. Such a consolidated Appeal Brief would make it easier for the Board of Patent Appeals and Interferences to review the Appeal. A communication from Examiner Rimell was received by facsimile on September 26, 2007 indicating that the offer was being denied since there was no provision in the rules for the filing of such a consolidated Appeal Brief. Since Appellants do not see anything in the rules preventing the filing of such a consolidated Appeal Brief, Appellants make the same offer to the Board of Patent Appeals and Interferences.

of Appellants' Amended Appeal Brief to read as follows:

There are two grounds of rejection presented for review:

1)   the rejection of claims 22 and 41-65 under 35 U.S.C. § 112, first

paragraph, for failing the written description requirement; and

2)   the rejection of claim 67 for being anticipated under 35 U.S.C. § 102(e) in

view of Borghesi et al.

C.   35 U.S.C. § 112, First Paragraph

1.   Encapsulation

In view of the Examiner maintaining his rejection of claims 22 and 41-65 under

35 U.S.C. § 112, first paragraph, for containing new matter, Appellants believe that a

brief discussion of the concept of encapsulation as applied to the invention of claim 22

would be helpful. Independent claim 22 recites a server component that includes an

event processor that interacts with a task engine application program to enable an

insurance claim to be processed. The recited server component generates a user

interactive interface that interactively displays at least one level relating to information,

such as information related to a policy or a claim. The display of the at least one level

allows "each of the users to simultaneously interact with a level "to retrieve and enter

data for the same insurance claim." In summary, the system of claim 22 performs at

least two functions: 1) processing of an insurance claim by the event processor and 2)

displaying at least one level relating to insurance information.

Claim 22 further mentions that the system has responsibilities of displaying

information and the event processor maintains clear encapsulation of such

responsibilities from itself. Appellants' Specification at page 185, lines 13-16 gives a

simple example of such encapsulation wherein an event that affects claim data is processed by the claim component, <u>not</u> the event processor 1400. It naturally follows encapsulation by the event processor regarding system responsibilities of displaying information will lead to such system responsibilities and functions regarding such displaying to be processed by a display component of the system and <u>not</u> the event processor 1400.

2.   <u>Passage at Page 185 is Relevant to Question of New Matter</u>

The Examiner at page 6 of the Examiner's Answer places no weight on the passage at page 185 of Appellants' Specification relied on at page 14 of Appellants' Amended Appeal Brief for the proposition that claim 22's phrase "do not include functions performed by said event processor," as amended on November 22, 2005, does not include new matter. In particular, the Examiner makes the observation that the passage regards what the event processor does/does not do while "the claim is referring to what the <u>system does/does not do</u>" (emphasis as in original). While the passage does regard what the event processor does/does not do, independent claim 22 recites:

> wherein the event processor maintains clear encapsulation
> of responsibilities of said system for displaying information
> from said event processor, wherein said responsibilities do
> not include functions performed by said event processor

The above clause of claim 22 clearly states that the responsibilities of the system of the system for displaying information that are maintained to be encapsulated by the event processor from itself "do not include functions performed by said event processor." Since the clause regards maintaining encapsulation of responsibilities by the <u>event</u>

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processor and the passage at page 185, lines 13-16 of Appellants' Specification states

that the event processor "maintains clear encapsulation of system responsibilities", the

passage at page 185, lines 13-16 is highly relevant to the question whether new matter

is present in claim 22.

3. There is Inherent Support in Appellants' Specification for the Disputed Clause

The only question remaining is whether there is support in Appellants' original

disclosure for the recitation in claim 22 that the responsibilities of the system that are

clearly encapsulated via the event processor "do not include functions performed by

said event processor." In particular, the Examiner asserts at pages 6 and 7 of the

Examiner's Answer that the clause "do not include functions performed by said event

processor" is new matter since one of ordinary skill would need to make multiple

sequential inferences in order to show that the clause is not new matter. This assertion

is not based on any legal authority. Appellants have presented in their Amended

Appeal Brief sufficient reasons why one of ordinary skill would be able to discern from

Appellants' original application, including the relied on passages at page 2, lines 12-15

and page 185, lines 13-16 (see pages 14-17 of Appellants' Amended Appeal Brief), that

the clause "do not include functions performed by said event processor" is supported by

the original disclosure. If such reasons include inferences that one of ordinary skill

would be able to make, then that should not be sufficient reason to reject the claims for

including new matter.

The Examiner at page 7 of the Examiner's Answer asserts that the quotation at

page 2, lines 12-15 of Appellants' Specification and relied on at page 15 of Appellants

Amended Appeal Brief "has virtually no relationship to the features indicated as new matter." Appellants disagree. The quotation explains the concept of encapsulation. Since the feature "do not include functions performed by said event processor" regards responsibilities of the system that are clearly encapsulated, the quotation would be highly relevant to one of ordinary skill in his or her understanding of the concept of encapsulation as pertaining to the disputed clause "do not include functions performed by said event processor."

The Examiner further dismissed the relevance of the above described quotation at page 2, lines 12-15 of Appellants' Specification at page 7 of the Examiner's Answer. For example, the Examiner stated that "[k]nowing that encapsulation is a feature of object oriented programming (discussed at first sentence of quotation) does not mean you can infer the functions of a system processor" (parenthetical information supplied). This statement ignores the second sentence of the quotation which states "[t]his concept of packaging data, structures, and procedures together in one component or module is called encapsulation." Obviously, the second sentence of the quotation would be relevant for one of ordinary skill in the art to determine whether the clause "do not include functions performed by said event processor" contains new matter for reasons similar to those given in the previous paragraph.

The Examiner criticizes the quotation at page 2, lines 12-15 of Appellants' Specification as being "merely a generic discussion of the prior art, disconnect from any discussion of the system to which the claims are drawn." Such an observation demonstrates the Examiner has missed the point of the quotation. The quotation is being relied on to understand the concept of encapsulation and then apply such

understanding to determine if new matter is present in claim 22. As shown in Section

C.1. above at pages 3-4, knowing the meaning of encapsulation would have helped one

of ordinary skill in the art to understand that encapsulation by the event processor

regarding system responsibilities of displaying information will lead to system

responsibilities and functions regarding such displaying to be processed by a display

component of the system and not the event processor 1400. The disputed clause "do

not include functions performed by said event processor" regarding system

responsibilities of displaying information is merely a rephrasing of encapsulation in that

the recited encapsulated responsibilities cannot be performed by the event processor

since they are sent to a display component or the like instead.

In summary, one of ordinary skill in the art would read the previously mentioned

passages at page 2, lines 12-15 and page 185, lines 13-16 of Appellants' Specification

in conjunction with the embodiment of the event processor of FIG. 14 to determine that

the event processor is compartmentalized in that it does not perform any of the

functions regarding other components of the system, such as the components of the

system for displaying information. Thus, there is support in Appellants' original

disclosure for the disputed clause "do not include functions performed by said event

processor."

At pages 15 and 16 of Appellants' Amended Appeal Brief, Appellants provided

arguments showing that allowing a mixture of functions by encapsulation would lead to

an inoperative device. The Examiner at page 8 of the Examiner's Answer asserts that

"[t]he issue of new matter has nothing whatsoever to do with the issue of operability." It

is apparent that the Examiner does not understand the gist of Appellants' argument.

Appellants are arguing that upon reviewing Appellants' original specification, one of

ordinary skill would readily understand that encapsulation as recited in claim 22

inherently does not allow a mixture of functions since allowing such a mixture of

functions would lead to an inoperable device. This interpretation of "encapsulation"

would be understood by one of ordinary skill in the art to be inherent since it is

necessary and inevitable to avoid having Appellants" disclosed embodiments

inoperable. *See, Chubb & Son's Lock & Safe Co. v. Omron Tateisi elec. Co.*, 196

USPQ 667 (D. D.C. 1976). In other words, one of ordinary skill would interpret

"encapsulation" in such a way so as that an operable device will result. Accordingly,

inoperability can be used by one of ordinary skill to determine the scope of the term

"encapsulation." This is an example where one of ordinary skill can fill in the gaps of the

specification to determine what is meant by "encapsulation" as recited in claim 22. *See,*

AK Steel Corp. v. Sollac, 344 F.3d 1234, 68 USPQ2d 1280 (Fed. Cir. 2003). Once the

scope of "encapsulation" is determined in the manner set forth on pages 14-16 of

Appellants' Amended Appeal Brief, then it is apparent that the disputed phrase "do not

include functions performed by said event processor" is consistent with that scope and

so does not involve new matter.

D.   35 U.S.C. § 102

Claim 67 was finally rejected in the Final Office Action of February 24, 2006

under 35 U.S.C. § 102(e) as being anticipated by Borghesi et al. Appellants provided

reasons at pages 20-21 of their Amended Appeal Brief showing why the rejection was

improper. In particular, Appellants showed why Borghesi et al. fails to disclose a

system that displays insurance claim information that includes a plurality of interfaces

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that allow a plurality of users "to simultaneously interact with one of the plurality of levels to retrieve and enter data on the same insurance claim" as recited in claim 67. The Examiner at page 9 of the Examiner's Answer asserts for the first time that the embodiment of FIG. 5 of Borghesi et al. discloses a system that allows a plurality of users to simultaneously interact with a level to retrieve and enter data on the same insurance claim. In particular, the Examiner relies on passages at lines 6 and 40-42 of column 7 as disclosing the recited system. However, a review the entire description of the embodiment of FIG. 5 at lines 1-53 of column 7 of Borghesi et al. reveals that there is no explicit description of allowing a plurality of users to simultaneously interact with a level to retrieve and enter data on the same insurance claim. Without such description, the rejection should be reversed.

The rejection should be reversed for the additional reason that Borghesi et al. fails to disclose an event processor that "determines a response for the data event and identifies a system component to process the response and transmits information for processing the claim to the identified system component" as recited in claim 67. The Examiner at page 9 of the Examiner's Answer identifies for the first time that either home office computer 30, claims office computer 32 or auditor computer 34 of the embodiment shown in FIG. 3 correspond to the recited event processor. This reliance on items 30, 32 and 34 is improper for several reasons. First, FIG. 3 is an embodiment different than the embodiment of FIG. 5. For an anticipation rejection, picking and choosing of elements from separate embodiments is improper and so the rejection should be reversed.

Should it be determined that the elements of FIGS. 3 and 5 are from the same embodiment, then the rejection should be reversed for the additional reason that there is no disclosure in Borghesi et al. to have either one of elements 30, 32 or 34 to determine a response for a data event and identify a system component to process the response and transmit information for processing the claim to the identified system component. The Examiner at page 9 of the Examiner's Answer asserts that elements 30, 32 or 34 determine a response for a data event by sending data. Appellants disagree. Claim 67 recites "determining" a response for a data event and not "providing" a response as the Examiner appears to interpreting the claim. The mere sending of data cannot be reasonably be interpreted to correspond to the recited determining a response for a data event.
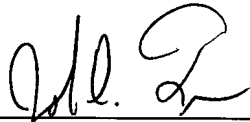
The Examiner's unreasonable interpretation of elements in Borghesi et al. continues at pages 9 and 10 of the Examiner's Answer. In particular, the Examiner asserts that either one of elements 30, 32 or 34 identifies a system component to process the response and transmit information for processing the claim to the identified system component. The Examiner asserts that the programs corresponding to items 200-218 mentioned at column 11, line 65 to column 12, line 13 correspond to the recited identified system components. The Examiner's assertion has no merit on several fronts. First, items 200-218 refer to data, not programs or components, that can be altered in a workfile (see column 12, lines 2-13). Second, the user, not elements 30, 32, 34, identifies data to be created or edited by selecting a tabbed section (see column 11, line 65 to column 12, line 13). Third, there is no mention in Borghesi et al. that items

200-218 process a claim. Instead, the user, not an event processor, merely adds or

alters data in items 200-218. Accordingly, Borghesi et al. fails to disclose the recited

event processor and so the rejection should be reversed.

For the reasons give above, Appellants respectfully submit that the rejections

should be reversed and the claims should be allowed.

Respectfully submitted,

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Dated: October 1, 2007